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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/014,797	12/14/2001	Steven M. Bessette	45112-200	1638

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EXAMINER

AFREMOVA, VERA

ART UNIT	PAPER NUMBER
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1651

DATE MAILED: 02/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.  
10/014,797

Applicant(s)  
Bessete et al.

Examiner  
Vera Afremova

Art Unit  
1651



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on Dec 23, 2002
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-139 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-139 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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### **DETAILED ACTION**

Claims 1-139 are pending and subject to restriction requirement.

#### ***Restriction***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1 and 2, drawn to a composition with rosemary oil alone, classified in class 424, subclass 745, for example.
- II. Claims 3 and 4, drawn to a method for controlling agricultural invertebrate pests with a rosemary oil containing composition, classified in class 424, subclass 745, for example.
- III. Claims 5-9, drawn to a composition with wintergreen oil alone, classified in class 424, subclass 725, for example.
- IV. Claims 10 and 11, drawn to a method for controlling agricultural invertebrate pests with a wintergreen oil containing composition, classified in class 424, subclass 725, for example.
- V. Claims 12-17, 20, 21, 22, 122, 123 and 126, drawn to a composition with both rosemary oil and wintergreen oil, classified in class 424, subclass 725, for example.
- VI. Claims 18 and 19, 23, 24, 124, 125 and 127, drawn to a method for controlling invertebrate pests with a composition containing both rosemary oil and wintergreen oil, classified in class 424, subclass 725, for example.

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- VII. Claims 25-29 and 128-133, drawn to a composition with wintergreen oil and phenylethyl propionate and to a method for controlling agricultural invertebrate pests with the composition, classified in class 424, subclass 725, for example.
- VIII. Claims 30-32, drawn to a composition with cinnamon oil, wintergreen oil and mineral oil, classified in class 424, subclass 739, for example.
- IX. Claims 33 and 34, drawn to a method for controlling agricultural invertebrate pests with a composition comprising cinnamon oil, wintergreen oil and mineral oil, classified in class 424, subclass 739, for example.
- X. Claims 35-39, drawn to a composition with wintergreen oil, phenylethyl propionate and castor oil and to a method for controlling agricultural invertebrate pests with the composition, classified in class 424, subclass 725, for example.
- XI. Claims 40-45, drawn to a composition with rosemary oil, wintergreen oil, phenylethyl propionate and mineral oil and to a method for controlling agricultural invertebrate pests with the composition, classified in class 424, subclass 725, for example.
- XII. Claims 46-50, drawn to a composition with sesame oil, rosemary oil, wintergreen oil, phenylethyl propionate and mineral oil and to a method for controlling agricultural invertebrate pests with the composition, classified in class 424, subclass 725, for example.

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- XIII. Claims 51-57, drawn to a composition with soybean oil, rosemary oil, wintergreen oil, phenylethyl propionate and mineral oil and to a method for controlling agricultural invertebrate pests with the composition, classified in class 424, subclass 757, for example.
- XIV. Claims 58-62, drawn to a composition with safflower oil, soybean oil, sesame oil, wintergreen oil and phenylethyl propionate and to a method for controlling agricultural invertebrate pests with the composition, classified in class 424, subclass 764, for example.
- XV. Claims 63-67, drawn to a composition with safflower oil, eugenol, soybean oil, wintergreen oil and phenylethyl propionate and to a method for controlling agricultural invertebrate pests with the composition, classified in class 424, subclass 764, for example.
- XVI. Claims 68-72, drawn to a composition with sesame oil, eugenol, safflower oil, soybean oil and wintergreen oil and to a method for controlling agricultural invertebrate pests with the composition, classified in class 424, subclass 725, for example.
- XVII. Claims 73-77, drawn to a composition with eugenol, sesame oil, safflower oil, soybean oil and wintergreen oil and to a method for controlling agricultural invertebrate pests with the composition, classified in class 424, subclass 725, for example.

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- XVIII. Claims 78-82, drawn to a composition with rosemary oil, wintergreen oil, safflower oil, mineral oil and phenylethyl propionate and to a method for controlling agricultural invertebrate pests with the composition, classified in class 424, subclass 745, for example.
- XIX. Claims 83-87, drawn to a composition with wintergreen oil, safflower oil, mineral oil and phenylethyl propionate and to a method for controlling agricultural invertebrate pests with the composition, classified in class 424, subclass 725, for example.
- XX. Claims 88-92, drawn to a composition with wintergreen oil, mineral oil, eugenol and safflower oil and to a method for controlling agricultural invertebrate pests with the composition, classified in class 424, subclass 725, for example.
- XXI. Claims 93-97, drawn to a composition with thyme oil, rosemary oil, wintergreen oil, mineral oil and safflower oil and to a method for controlling agricultural invertebrate pests with the composition, classified in class 424, subclass 745, for example.
- XXII. Claims 98-102, drawn to a composition with rosemary oil, wintergreen oil, mineral oil, phenylethyl propionate, soybean oil, safflower oil, and to a method for controlling agricultural invertebrate pests with the composition, classified in class 424, subclass 745, for example.

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XXIII. Claims 103 and 104, drawn to a composition with castor oil and wintergreen oil, classified in class 424, subclass 731, for example.

XXIV. Claims 105 and 106, drawn to a method for controlling invertebrate pests with a composition comprising castor oil and wintergreen oil, classified in class 424, subclass 731, for example.

XXV. Claims 107-111, drawn to a composition with rosemary oil, wintergreen oil, mineral oil, lecithin and water and to a method for controlling agricultural invertebrate pests with the composition, classified in class 424, subclass 745, for example.

XXVI. Claims 112-116, drawn to a composition with wintergreen oil, mineral oil, phenylethyl propionate and vanillin and to a method for controlling invertebrate pests with the composition, classified in class 424, subclass 725, for example.

XXVII. Claims 117-121, drawn to a composition with cinnamon oil, wintergreen oil, mineral oil, phenylethyl propionate and vanillin and to a method for controlling invertebrate pests with the composition, classified in class 424, subclass 739, for example.

XXVIII. Claims 134-139, drawn to a composition with rosemary oil and benzyl alcohol and to a method for controlling invertebrate pests with the composition, classified in class 424, subclass 745, for example.

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The inventions are distinct, each from the other because of the following reasons:

The compositions listed above require different components as claimed. The particular combination of components in one composition is neither present nor necessarily required in the compositions of the other groups. Thus, all groups as claimed are drawn to the use of distinct compositions. The search for each of the above compositions is not co-extensive particularly with regard to the literature search. Further, a reference which would anticipate one composition and its application would not necessarily anticipate or make obvious any of the other compositions and their applications.

The claimed inventions listed above are related as product and process of use. The inventions can be shown to be distinct if **either** or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, with respect to the claims 1-11, the compositions with rosemary oil alone and/or with wintergreen oil alone can be used for treating inflammation, for example: see US 5,888,984 at col. 11, table 1. With respect to the claims 12-24 and claims 122-127, the compositions comprising both rosemary oil and wintergreen oil can be used as food products and/or therapeutic products, for example: see US 5,248,503 at col. 2, line 48. With respect to the claims 30-34, the compositions with wintergreen oil, cinnamon oil and mineral oil can be used for treating hair and scalp, for example: see US 4,999,187 at col. 2, lines 30-36. With respect to the claims 103-106, the compositions with wintergreen oil and castor oils



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can be used as food product and/or therapeutic products, for example: US 5,248,503 at col.2, lines 48-51.

Therefore, the several inventions listed above are independent and distinct from one another as they have acquired a separate status in the art and require independent searches, particularly with regard to the literature searches. Clearly, a reference which would anticipate one of the above groups would not necessarily anticipate or even make obvious any of the others. Because these inventions are distinct for the reasons given above restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vera Afremova whose telephone number is (703) 308-9351. The examiner

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can normally be reached on Monday to Friday from 9:00 to 5:30. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn, can be reached on (703) 308-4743. The fax phone number for this Group is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Vera Afremova

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February 20, 2003.

VERA AFREMOVA

PATENT EXAMINER

A handwritten signature in cursive script, appearing to read 'V. Afremova', with a long horizontal flourish extending to the right.